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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,698	01/30/2001	Adrian P. Wise	100415(EP)USC1X1C1D4 PDDD	1171

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER	
JEAN, FRANTZ B	

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/772,698	WISE ET AL.	
	Examiner	Art Unit	
	Frantz B. Jean	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 January 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/30/01*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is a first office action in response to an application for patent filed on 1/30/2001.

Claims 1-26 are presented for examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 1/30/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The disclosure is objected to because it references multiple related patent applications that do not reflect their current status including associated patent numbers. Correction is required. See MPEP § 608.01(b).

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

> The oath or declaration is defective because: In the original oath filed on 1/30/2001 applicants claim priority of US Patent Application Number 08/382,952. However, the cross reference to related application of the disclosure refer to US Application Number 08/382,958, which is different than the application mentioned above. Correction is required.

Priority

Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09/307,239 under 35 U.S.C. 119(a)-(d) or (f), a claim for such foreign priority must be timely made in this application. To satisfy the requirement of 37 CFR 1.55(a)(2) for a certified copy of the foreign application, applicant may simply identify the application containing the certified copy.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09689,120. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broader than the claims of application "120", which encompass the same metes, bounds, and limitations. Therefore, it would have been obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same function as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,330,666, claims 1-55 of US Patent 6,263,433, claims 1-13 of US Patent 6,892,296 and claims 1-11 of US Patent 6,910,125. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the claims of the instant application are arguably broader than the claims of Patents "666", "433", "296", and "125", which encompass the same metes, bounds, and limitations. Therefore, it would have been obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same function as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 14-18 and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvath et al. Hereinafter "Horvath" US Patent Number 5,450,599.

As per claims 1 and 14, Horvath teaches a multiple stage processing pipeline (sequential process-pipeline) and a method for handling bit streams encoded in accordance with different standards and arranged as a single serial bit stream (see abstract), the multiple stage processing pipeline comprising: a token generator (blocks) responsive to the single serial bit stream for generating tokens (see col. 1 lines 20-32;

col. 7 line 63-col. 8 line 2); and at least one reconfigurable processing stage (dynamically modify processing control parameters) configured to respond to the generated tokens by processing different portions of the single serial bit stream corresponding to different ones of the different standards (see col. 1 lines 20-51; col. 2 lines 45-55).

As per claims 2 and 15, Horvath teaches the at least one reconfigurable processing stage comprises: a token decoder (decoding compressed blocks of image) for recognizing ones of the generated tokens as control tokens pertinent to that at least one reconfigurable processing stage and for passing unrecognized ones of the generated tokens to another of the stages (col. 4 line 60-col. 5 line 11; col. 9 lines 3-31).

As per claims 3 and 16, Horvath teaches the at least one reconfigurable processing stage further comprises: an action identification unit responsive to at least one of the control tokens for reconfiguring the at least one reconfigurable processing stage to process a data token identified by the at least one control token according to one of the different standards (col. 9 line 55-col. 10 line 37).

As per claim 4, Horvath teaches the token generator, the action identification unit and the token decoder are implemented in hardware (see fig 1).

As per claims 5-6 and 17-18, Horvath teaches the different standards that include

MPEG and JPEG (see col. 1 lines 33-36).

As per claim 20, Horvath teaches a system comprising:

a detector unit for receiving a data stream of data having portions encoded according to different standards and for generating tokens (blocks) based on respective portions of the received data stream (see col. 1 lines 20-32; col. 7 line 63-col. 8 line 2); and a processor (fig 1) configured to respond to the generated tokens by processing the respective portions of the single serial bit stream corresponding to different standards to produce a decoded output (see col. 1 lines 20-51; col. 2 lines 45-55).

As per claim 21, Horvath teaches a system of claim 20, wherein the processor (see fig 1) comprises a pipeline processor having at least one reconfigurable processing stage (abstract; col. 1. lines 33-51).

As per claim 22, Horvath teaches a system of claim 21, that further comprising: a token decoder (decoding compressed blocks) for recognizing ones of the generated tokens as control tokens pertinent to that at least one reconfigurable processing stage (col. 4 line 60-col. 5 line 11; col. 9 lines 3-31).

As per claim 23, Horvath teaches a system of claim 21, wherein the at least one reconfigurable processing stage (dynamically modify processing control parameters for blocks) comprises: an action identification unit responsive to at least one of the control tokens for reconfiguring the at least one reconfigurable processing stage to process a

data token identified by the at least one control token according to one of the different standards (col. 9 line 55-col. 10 line 37).

As per claims 24-25, Horvath teaches a system of claim 20, wherein the different standards include MPEG and JPEG (see col. 1 lines 33-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-13, 19, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvath in view of Ackland et al. hereinafter "Ackland" Us patent number 5,220,325.

As per claims 7, 19, and 26, Horvath does not explicitly detail on H.261 standard. However, it must be noted that H.261 standard is well known in the art as evidence by the teachings of Ackland to provide video telephony data. It would have been obvious to one of ordinary skill artisan at the time of the invention to have incorporated H.261 standard into Horvath image processing to expand the system capability in dealing with and presenting compressed digitized video information (see Ackland col. 1 lines 32-45).

As per claims 8-10, Horvath does not teach a spatial decoding stage and a temporal decoding stage. Ackland teaches a spatial decoding stage and a temporal decoding stage (see Ackland col. 1 lines 23-31). These features are well known in the art at the time of the invention for the purpose of recognizing the control tokens and for temporally and spatially representing image or video sequence (see Ackland col. 1 lines 23-31).

As per claims 11-13, Horvath-Ackland deal with a reconfigurable prediction filters block (see Horvath col. 7 lines 35-39).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean

FRANTZ B. JEAN
PRIMARY EXAMINER